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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,580	05/22/2000	Frank McKeon	HMSU-P01-048	1156

25181 7590 02/16/2005

FOLEY HOAG, LLP
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EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1653

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/575,580	Applicant(s) MCKEON ET AL.	
	Examiner Chih-Min Kam	Art Unit 1653	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 8-13.
 Claim(s) objected to: _____.
 Claim(s) rejected: 2 and 14-16.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

In the amendment of January 14, 2005, claim 2 has been amended; claims 1-3 and 3-7 have been cancelled; and new claims 14-16 have been added. The amendment to claim 2 resolves new matter issue, however, it does not resolve the current issue under 35 USC 112, first paragraph. Applicants' response has been fully considered, however, claims 2 and 14-16 are rejected under 35 USC 112, first paragraph as follows.

1. The objection to the specification regarding new matter is withdrawn.

2. Claims 2 and 14-16 are rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 2 and 14-16 are directed to a nucleic acid molecule comprising a nucleotide sequence which is at least 80% (or 90%, 95% or 98%) identical to the nucleotide sequence of SEQ ID NO:2 over its entire length. The specification indicates the nucleotide sequence of calcipressin 1 (SEQ ID NO:2) which encodes the polypeptide of calcipressin 1 (Table 1), a nucleic acid sequence encoding calcipressin can be at least 80% sequence identity to SEQ ID NO:2 (page 28, lines 17-23), and various programs can be used to determine the sequence identity (page 25), however, the specification does not specify which portion of the nucleotide sequence is at least 80% (or 90%, 95% or 98%) identical to SEQ ID NO:2, nor demonstrates these sequences encode a functional protein. Without guidance on the identity of nucleotide sequence that is at least 80% identical to SEQ ID NO:2, one skilled in the art cannot envision all the contemplated nucleotide sequences. The lack of representative examples and teachings for the nucleotide sequence that has at least 80% (or 90%, 95% or 98%) sequence identity to SEQ ID NO:2 as encompassed by the claims, applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise terms that a skilled artisan would not recognize applicants were in possession of the claimed invention.

In response, applicants indicate claim 2 has been amended and the amendment is supported by the specification; and Examiner has indicated the specification contains extensive teachings about how to identify nucleic acids that fall within claim limitations regarding sequence identity in the previous Office Action (pages 7-8 of the response).

Applicants' response has been fully considered, however, the argument is not found persuasive because the specification does not identify any nucleotide sequence that is at least 80% (or 90%, 95% or 98%) identical to SEQ ID NO:2, and whether these sequences encode a functional protein. Without representative examples and sufficient teachings on the homologous sequences, one skilled in the art would not recognize applicants were in possession of the claimed invention. Regarding Examiner's statement on sequence identity, Examiner merely recites applicant's statement in the response and finds the argument is not persuasive (see page 5, second paragraph of the Office Action dated October 13, 2004).

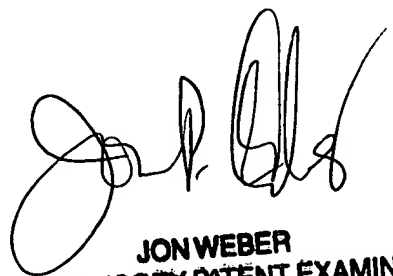
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Patent Examiner

CMK
February 10, 2005



JON WEBER
SUPERVISORY PATENT EXAMINER